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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/325,219	10/21/1994	CHRISTIAN SCHADE	43168	6064

26474 7590 09/28/2006

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EXAMINER

ZALUKAEVA, TATYANA

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/325,219

Applicant(s)

SCHADE ET AL.

Examiner

Tatyana Zalukaeva

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-15, 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Prosecution Application

1. The request filed on 05/20/2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/325,219 is acceptable and a CPA has been established. An action on the CPA follows.
2. Claims 10-15 and 17 are pending, claims 10, 15 and 17 are amended.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

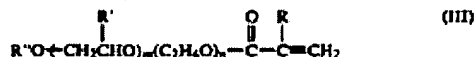
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims rejected under 35 U.S.C. 102(b) as being anticipated by Sonnabed (U.S. 4,384,096).
5. Sonnabed discloses cosmetic composition (abstract) comprising an emulsion polymer prepared by radical copolymerization of (A) 15-60% by weight of unsaturated carboxylic acid copolymer, such as acrylic or methacrylic acid and (B) about 15-80 weight percent of a nonionic copolymerizable C₂ – C₁₂ alpha.,beta.-ethylenically unsaturated monomer, preferably a monovinyl ester. This reads on alkyl esters of C₈-C₃₀ monocarboxylic acids, as per instant claims 10 and 17.

With regard to claims 11-15, Sonnabed discloses the third comonomer

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The third required monomer component is about 1-30 weight percent based on total monomers of a non-ionic vinyl surfactant ester of the formula:

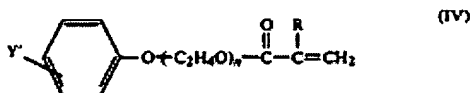


where

R is H or CH₃; each R' is C₁–C₂ alkyl; R'' is C₈–C₂₀ alkyl or C₈–C₁₆ alkylphenyl; n is an average number from about 6–100 and m is an average number from about 0–50 provided that n ≥ m and Σ(n+m) is about 6–100.

Preferred are the acrylate and methacrylate surfactant esters selected from the group consisting of:

(1) alkylphenoxypoly(ethyleneoxy)ethyl acrylates of the formula:



where

R is H or CH₃; Y' is C₈–C₁₆ alkyl, and n is about 6–100;

(2) alkoxypoly(ethyleneoxy)ethyl acrylates of the formula:



where

R is H or CH₃; R'' is C₈–C₂₀ alkyl, and n is about 6–50; and

(3) alkoxypoly(alkyleneoxy)ethyl acrylates of the formula:

This comonomer can be present in the amount of 1-30 % by weight. See col. 4,

lines 30-65, and the comonomer presented by the formula (IV) in col.5, line 1.

This reads on the comonomer (B) of the instant claims. All the polymers are obtained by radical polymerization.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-15 and 17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over SU 428347.

SU'347 discloses a composition based on copolymers containing molar ratio acrylic (or methacrylic) acid: oleic acid: neutral monomers = 0.7-1.1:0.005-0.2:1.0 resp. The comps. contains usual initiators, colourants, solvents etc. In an example, 80 g 39% isopropanoic solution of copolymer (methacrylic acid: oleic acid: butyl methacrylate = 0.9:0.2:1.0) is shown. Therefore the comonomers and their relative ratios in SU'347 are

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identical to those of the instant claims. It is noted that most of Applicants' examples include acrylic acid and oleic acid. With regard to the utility of the polymer as being a dispersant or a thickener in cosmetic or pharmaceutical composition, it is noted that the discovery of a new property for a previously known composition cannot impart patentability of the known composition. See *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); *Titanium Metals Corp. of Am. v. Banner*, 778 F.2d at 780, 227 USPQ at 777-778. Likewise the prior art reference disclosing the composition need not disclose a utility to defeat patentability under 35 U.S.C. § 102. In *re Schoenwald*, 964 F. 2d 1122, , 1123-1124, 22 USPQ 2d. 1671, 1672-1673 (Fed. Cir. 1992).

It is noted here that the compounds claimed by Applicants present a genus having myriads of species. At this time no election of species has been requested, however, Applicants are advised that since 37 CFR 1.142(a) provides that restriction is proper at any stage of prosecution up to final action, a requirement may be made when it becomes proper, even though there was a prior requirement with which applicant complied. *Ex parte Benke*, 1904 C.D. 63, 108 O.G. 1588 (Comm'r Pat. 1904).

Any inquiry concerning this communication should be directed to Tatyana Zalukaeva at telephone number (571) 272-1115.

Tatyana Zalukaeva
SPE
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TATYANA ZALUKAEVA
SUPERVISORY PRIMARY EXAMINER

